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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,098

02/19/2004

Carmen Flosbach

FA1224USNA

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E I DU PONT DE NEMOURS AND COMPANY  
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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/782,098	FLOSBACH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rabon Sergeant	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 3, 2006 has been entered.
2. Claims 1, 4, 7, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have claimed that the hydroxy-C2-C4-alkyl (meth)acrylate component is selected from the group consisting of hydroxyethylacrylate and hydroxypropylacrylate; however, this language is confusing, because the recited species do not encompass C4 alkyl groups or methacrylate groups. It is unclear why presumably excluded species are encompassed by the language specifying or identifying the Markush group.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 4, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/25359.

The reference discloses polyurethane diacrylates and powder coatings derived from the polyurethane diacrylates, wherein the polyurethane diacrylates are produced from the reaction of hexane diisocyanate with ethylene glycol, butanediol, and hydroxyethyl acrylate in a molar ratio that meets that claimed. See example 5 on page 46 and examples 3 and 4 on pages 49-51. Though other mixtures of diols are not exemplified that specifically meet those claimed, the reference does disclose the use of other diol species that meet those claimed at page 22, lines 18-25. Since the diols of the exemplified blend are included within this listing of diols, this listing essentially establishes the equivalency of the disclosed other diol species to those of the example. Accordingly, it would have been *prima facie* obvious to utilize any of the disclosed diols in the form of blends in the production of the polyurethane diacrylates, in accordance with the teachings of the example.

5. Applicants have argued that their invention yields unexpected results over the prior art and have provided 37 CFR 1.132 declarations to demonstrate these results. The examiner has considered applicants' declarations; however, the declarations are deficient, because the examples of the declarations are not commensurate in scope with the claims. The claims encompass fractional values of X and molar ratios of the diols that are not exemplified within the declaration. For example, it would seem that the most relevant showings would be where X equals 2.5, since the claims encompass such a value and the prior art specifically exemplifies


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such a value; however, no showings have been provided for this value. It has been held that evidence of unexpected results must pertain to the full extent of the subject matter claimed. *In re Ackermann*, 170 USPQ 340; *In re Chupp*, 2 USPQ2d 1437, 1440; *In re Murch*, 175 USPQ 89. Accordingly, it has been held that to overcome a reasonable case of *prima facie* obviousness, a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Furthermore, it has been held that a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. For these reasons, applicants' declaration is insufficient to overcome the prior art rejection. Applicants' argument with respect to the criticality of a range is not understood, since the position is taken that the ranges are relevant to the obviousness or nonobviousness of the invention.

6. It is noted that WO 01/25359 corresponds to U.S. Patent 6,825,241.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
January 3, 2007

  
RABON SERGENT  
PRIMARY EXAMINER